

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q62027

Sang-hyun SHIN

Appln. No.: 09/774,008

Group Art Unit: 2154

Confirmation No.: 2294

Examiner: Ashokkumar B. PATEL

Filed: January 31, 2001

For: IP-BASED COMMUNICATION SYSTEM BETWEEN TERMINALS AND METHOD
THEREOF

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is SAMSUNG ELECTRONICS CO., LTD., (Assignee) by virtue of an assignment executed by the inventor (Appellant), Sang-hyun SHIN, on March 20, 2001, and recorded by the Assignment Branch of the U.S. Patent and Trademark Office on June 25, 2001 (at Reel 011968, Frame 0918).

II. RELATED APPEALS AND INTERFERENCES

Applicant submits that the claims were rejected in a Final Office issued August 25, 2006. In response, the Applicant filed a Notice of Appeal and a Pre-Appeal Brief Request for Review on December 26, 2006. The February 26, 2006 Notice of Panel Decision from Pre-Appeal Brief Review stated that the application remains under appeal.

Upon information and belief, there are no other pending appeals, interferences, or judicial proceedings known to Appellant, Appellant's representatives or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-9, 12 and 15-18 are all the claims pending in the application.

Claims 1-9, 12 and 15-18 remain rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0006803 (hereinafter "Mendiola").

Claims 1-9, 12 and 15-18, which have been at least twice rejected, are the claims on appeal (See Claims Appendix).

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IV. STATUS OF AMENDMENTS

The claims on appeal, claims 1-9, 12 and 15-18, have not been amended subsequent to the final rejection of August 25, 2006.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention relates to an Internet protocol (IP)-based communication system in a mobile telephone network, and method thereof, and more particularly, to a communication system which allows IP-based communication regardless of whether an IP connection exists in a mobile communication network. Abstract of Applicant's Specification.

Independent claim 1 is directed to “[a] method of performing an Internet protocol (IP)-based communication between wireless terminals. (p. 5, lines 2-8). Claim 1 requires “receiving a request for an IP address of a second terminal from a first terminal.” (p. 7, lines 14-16). “[U]pon receipt of the request, checking whether an IP address corresponding to the second terminal is registered.” (p. 7, lines 18-20). Claim 1 also requires “if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server.” (p. 7, line 19 - p. 8, line 3). Lastly, claim 1 requires “wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal.” (p. 7, lines 14-16 and Fig. 2).

Independent claim 7 is directed to “[a] communication system having a first wireless terminal and a second wireless terminal, an Internet protocol (IP) address server, and a name server for providing an IP address at the request of the first wireless terminal.” (p. 5, lines 2-8). The claims requires “wherein the name server comprises a database for storing IP addresses corresponding to telephone numbers of a plurality of terminals, said plurality of terminals including the second wireless terminal.” (p. 6, lines 1-4). The claim further requires “a controller which assigns an IP address to the second wireless terminal corresponding to information from the IP address server, if the IP address of the second wireless terminal that is

requested by the first wireless terminal using a telephone number is not registered, and registers the assigned IP address in the database. (p. 6, lines 1-10; and p. 6, line 16 - p. 7, line 2).

Independent claim 8 requires “[a] name server in an internet protocol (IP)-based communication system.” (p. 5, line 21 - p. 6, line 4). Claim 8 further requires “a communication module unit for sending and receiving IP-based data.” (p. 6, lines 16-19). Claim 8 also requires “a controller for registering telephone numbers and requests for translation of wireless telephone numbers into IP addresses.” (p. 6, lines 19-22). Moreover, claim 8 requires a database for storing IP addresses and wireless telephone numbers as determined by the controller. (p. 7, lines 3-4). Lastly, claim 8 requires “wherein the communication module unit sends and receives IP-based data to and from external devices and the external devices include IP address servers.” (p. 6, lines 16-19).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-9, 12 and 15-18 remain rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0006803 (hereinafter "Mendiola").

VII. ARGUMENT

A. Summary of Rejection

In rejecting the claims, the Examiner alleges that Mendiola discloses each and every element of independent claims 1, 7 and 8. Specifically, the Examiner alleges that Mendiola discloses checking whether an IP address corresponding to the second terminal is registered (claim 1); a controller which assigns an IP address to the second wireless terminal corresponding to information from the IP address server, if the IP address of the second wireless terminal that is requested by the first wireless terminal using a telephone number is not registered, and registers the assigned IP address in the database (claim 7); and a communication module unit for sending and receiving IP-based data, a controller for registering telephone numbers and requests for translation of wireless telephone numbers into IP addresses, and a database for storing IP addresses and wireless telephone numbers as determined by the controller, wherein the communication module unit sends and receives IP-based data to and from external devices and the external devices include IP address servers (claim 8).

In view of the following discussions, Applicant respectfully disagrees.

B. Each and Every Element of Claim 1 is Not Disclosed by Mendiola

Applicant respectfully submits that claim 1 is patentable over Mendiola because each and every element of claim 1 is not disclosed or suggested by Mendiola.

Specifically, claim 1 recites:

A method of performing an Internet protocol (IP)-based communication between wireless terminals, the method comprising the steps of:

- (a) receiving a request for an IP address of a second terminal from a first terminal;
- (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and
- (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server,
wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal.

In response to the May 22, 2006 Amendment, the Examiner asserts “the [Mendiola] reference teaches the IP address are being exchanged for the transmission of the instant messages.” See Final Office Action at p. 3. In the Advisory Action of December 13, 2006, the Examiner further clarifies his position by arguing that “the assigned [Unique Identification Number] is an IP address” See Continuation Sheet of Advisory Action at p. 4. Applicant submits that the Examiner is incorrect in alleging that UIN of Mendiola discloses the IP address as recited in claim 1.

First, the IP address recited in claim 1 refers to and Internet Protocol address. See e.g., Specification at page 5, lines 2-4. Therefore, the address complies with the Internet Protocol (see e.g., Specification at page 7, lines 7-11), whereas there is nothing in Mendiola which suggests that the UIN complies with the Internet Protocol. See paragraph 117 (UIN of “12125556666”).

Even assuming arguendo, that the UIN corresponds to the claimed IP address, Applicant submits that Mendiola fails to disclose or suggest a method wherein (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and (c) if the IP address is not registered, assigning an IP address to the second terminal

corresponding to information from an IP address server, in combination with other elements of the claim.

Rather, Mendiola merely discloses the registering of a user and fails to disclose any sort of checking to determine whether a UIN corresponding to the user is registered. In other words, Mendiola discloses assigning a new UIN to the user without determining whether any UIN has been previously assigned to the user. See paragraph 0109.

On page 5 of the Advisory Action, the Examiner attempts to point out that paragraphs 117 and 118 of Mendiola disclose the claimed checking as recited in claim 1. Paragraph 117, however, merely discloses that “[t]he registration handler [sic] 119 of the IM server system 113 causes the UIN assigner to generate a UIN to be assigned and matched to John Smith’s email address in the manner previously described. For this specific illustration, UIN 12125556666 is matched to johnsmith@company.com” Paragraph 118 merely discloses that a message is sent to a target new user. In other words, Mendiola does not disclose that the registration handler 119 checks to see if a UIN was previously matched to John Smith’s email.

Therefore, Mendiola cannot possibly disclose the checking as recited in the claim.

In addition to the above, Applicant submits that if the IP address is not registered, claim 1 recites assigning an IP address to the second terminal corresponding to information from an IP address server. Thus, claim 1 requires a particular relationship between the claimed checking in (b) with the claimed assigning in (c), a relationship which is not found in Mendiola.

For at least the above reasons, claim 1 is patentable.

Claims 7 and 8 are patentable for reasons similar to those submitted for claim 1.

Claims 2-6, 17 and 18 which depend from claim 1, claims 15 and 16, which depend from claim 7, and claims 9 and 12, which depend from claim 8, are patentable for at least the reasons submitted for their respective base claims.

C. Conclusion

Applicant submits that the Examiner is attempting to arbitrarily characterize the teachings of Mendiola as corresponding to the features of claims 1, 7 and 8 in a manner that is inconsistent with the specific recitations of claim 1 and the interrelationships between the specific claim recitations. Therefore, each and every element of the independent claims 1, 7 and 8 are not disclosed by Mendiola.

Accordingly, Applicant hereby submits that the Examiner has failed to show that claims 1, 7 and 8 are anticipated by Mendiola, as required under 35 U.S.C. § 102, and hereby submits that claims 1, 7 and 8 are patentable. Claims 2-6, 17 and 18, claims 15 and 16, and claims 9 and 12, are patentable for at least the reasons submitted for their respective base claims. Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: July 26, 2007

CLAIMS APPENDIX

CLAIMS 1-9, 12 and 15-18 ON APPEAL:

1. A method of performing an Internet protocol (IP)-based communication between wireless terminals, the method comprising the steps of:
 - (a) receiving a request for an IP address of a second terminal from a first terminal;
 - (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and
 - (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server,

wherein the first terminal is a first wireless terminal and the second terminal is a second wireless terminal.
2. The method of claim 1, wherein in the step (a), the request for an IP address is made using a telephone number, and wherein in the step (b), checking whether an IP address corresponds to the second terminal is carried out by checking whether the telephone number corresponds to the second terminal.
3. The method of claim 1, further comprising the step of sending a notice requesting the second terminal to establish an IP connection if the IP address is not registered.
4. The method of claim 3, wherein in the step of sending a notice requesting the second terminal to establish an IP connection, said notice is sent using a Short Message Service (SMS).

5. The method of claim 1, wherein if the IP address is registered, further comprising the step of transmitting the IP address to one of a plurality of terminals, said plurality of terminals including said first terminal.

6. The method of claim 5, wherein the IP address is transmitted to said one of a plurality of terminals using transmission control protocol/internet protocol (TCP/IP) or user datagram protocol/internet protocol (UDP/IP).

7. A communication system having a first wireless terminal and a second wireless terminal, an Internet protocol (IP) address server, and a name server for providing an IP address at the request of the first wireless terminal, wherein the name server comprises:

a database for storing IP addresses corresponding to telephone numbers of a plurality of terminals, said plurality of terminals including the second wireless terminal; and

a controller which assigns an IP address to the second wireless terminal corresponding to information from the IP address server, if the IP address of the second wireless terminal that is requested by the first wireless terminal using a telephone number is not registered, and registers the assigned IP address in the database.

8. A name server in an internet protocol (IP)-based communication system comprising:
a communication module unit for sending and receiving IP-based data;
a controller for registering telephone numbers and requests for translation of wireless telephone numbers into IP addresses; and
a database for storing IP addresses and wireless telephone numbers as determined by the controller,

wherein the communication module unit sends and receives IP-based data to and from external devices and the external devices include IP address servers.

9. The name server of claim 8, wherein the name server further comprises a memory for storing a program for operating the controller.

12. The name server of claim 8, wherein the controller receives requests for translation of telephone numbers into IP addresses from the communication module unit.

15. The communication system of claim 7 further comprising a communication module unit which sends the assigned IP address to the first wireless terminal.

16. The communication system of claim 7, wherein said name server receives a request for the IP address of the second wireless terminal from the first wireless terminal.

17. The method of claim 1, wherein the IP address corresponding to the second terminal or the IP address assigned to the second terminal is unique to the second terminal.

18. The method of claim 17, wherein the IP address corresponding to the second terminal or the IP address assigned to the second terminal is transmitted to the first terminal.

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EVIDENCE APPENDIX:

This Appendix is not applicable to this Appeal.

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RELATED PROCEEDINGS APPENDIX

This Appendix is not applicable to this Appeal.

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Submitted herewith please find an Appeal Brief. The statutory fee of \$500.00 is being charged to Deposit Account No. 19-4880 via EFS Payment Screen. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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